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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEYHAN KARAOGUZ
and JAMES D. BENNETT

Appeal 2010-004430
Application 10/667,036
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W. FETTING, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

STATEMENT OF CASE

This is a decision on rehearing in Appeal No. 2010-004430. We have jurisdiction under 35 U.S.C. § 6(b).

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision. 37 C.F.R. § 41.52.

ISSUES ON REHEARING

Appellants raise 3 issues in the Request for Rehearing. The first issue relates to whether the panel misapprehended whether the art describes the limitation of "allowing at least one user to create at least one user defined media channel" in claim 40.[1]

[1] Claim 40 reads as follows:
40. A system comprising:
a user interface for the selection and display of media content, the user interface allowing at least one user to create at least one user defined media channel, wherein the at least one user selects media content for the at least one user defined media channel through the user interface, and the at least one user specifies, through the user interface, times when the user selected media content will be made available via the at least one user defined media channel, the user interface displaying a graphical representation of the at least one user defined media channel comprising a sequence of the user selected media content for consumption at the times specified by the at least one user.

The second issue relates to whether the panel misapprehended whether the art describes three locations as in claim 46.[2]

The third issue relates to whether the panel concluded improperly whether patentable weight is to be afforded the limitation of the request comprising information securing payment for delivery in claim 46.

The Appellants also request that we clarify what appears to be a typographic inconsistency between the Conclusions of Law and Decision sections of the Decision.

ANALYSIS

We found in our decision that the rejection of claims 40-53 under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is proper. (Decision 7).

First Issue

The Appellants argue that the panel misapprehended that there is no enabling disclosure in Schein or Future TV that expressly or necessarily describes a user-defined media channel. (Request 3). We find this unpersuasive.

As the panel found at Decision 6, claim 40, the broadest claim, is to a system, and so steps doing anything with a user defined media channel would be irrelevant.

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[2] Claim 46 reads as follows:
46. A system comprising:
at least one server at a first location, the at least one server configured to store media content; and server software that receives via a communication network a request for the delivery of the media content from the at least one server at the first location, the request comprising information securing payment for delivery, and that responds by coordinating the delivery of the media content from the at least one server at the first location to a storage at a second location to a television display at a third location for consumption.

Instead, the structure must simply be capable of performing what claim 40 recites. Claim 40 allows a user to create such a user defined media channel and displays a graphical representation of a user defined media channel. Schein allows a user to enter information and displays information that would be useful in creating such a user defined media channel.

Accordingly, the panel found that claim 40 is broad enough to encompass Schein's permitting and displaying the data called for in claim 40, even though Schein does not explicitly create such a user defined media channel. The panel was unpersuaded by the Appellants' argument that Future TV is a non-enabling reference since Future TV explicitly states that the technology it describes was already in the possession of those of ordinary skill.

Again, it was sufficient that such technology inherently provide the capacity for allowing, i.e. permitting, a user to create a user defined media channel. The claim does not specify that such creation occurs on the recited system, but only that such creation be permitted.

As Schein described a user interface that permitted a user to specify media content and times, and Future TV provided at least the suggestion of user specified media, the combination of the references were found to at least permit user creation of such media content, should a user so desire. Since the claim does not recite the actual creation of such content, enablement of such creation is not at issue.

Second Issue

The Appellants contend that the panel misapprehended the requirement for 3 locations in claim 46. Request 6. We find this unpersuasive. The panel found Schein receives requests for a guide at a server, from which the guide is

downloaded to a local computer for display on a screen or TV. Decision 6. Thus, Schein describes 3 separate physical entities, *viz.* server, computer, and TV, each of which occupies a location separate from the others. The claim does not specify any minimum distance separating the locations.

Third Issue

The Appellants finally contend that the panel should have afforded patentable weight to the limitation of the request comprising information securing payment for delivery in claim 46. The Appellants cite various MPEP sections and related cases concerning the use of functional limitations in support of this contention. Presumably, the Appellants contend the panel misapprehended the law pertaining to the contents of data entered into an apparatus that is defined by a claim.

It appears that the Appellants have instead misapprehended the panel's findings and are conflating functional limitations with apparatus contents limitations. Claim 46 is an apparatus claim. As such, the contents of data that is entered, not being a structural element of the apparatus, does not itself serve to define the apparatus. "[E]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (BPAI 1969). Furthermore, "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Otto*, 312 F.2d 937, 940 (CCPA 1963).

CONCLUSION

Nothing in Appellants' request has convinced us that we have overlooked or misapprehended the art or claims as argued by Appellants. Accordingly, we DENY the request that we reverse the rejection of claims 40-53.

We clarify, as the Appellants' request, that the rejection affirmed pertains to claims 40-53, and not to claims 1-53.

DECISION

To summarize, our decision is as follows:

- We have considered the REQUEST FOR REHEARING.
- We DENY the request that we reverse the Examiner as to claims 40-53
- We GRANT the request that we clarify our original decision
    - The rejection of claims 1-39 under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is not sustained.
    - The rejection of claims 40-53 under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is sustained.

REHEARING GRANTED-IN-PART

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